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10/541,069	04/21/2006	Ernst Keller	KELLER17	6116
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EXAMINER				
MERLINO, ALYSON MARIE				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/541,069

**Applicant(s)**

KELLER ET AL.

**Examiner**

ALYSON M. MERLINO

**Art Unit**

3673

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. The examiner acknowledges applicant's cancellation of claims 1-20 and the addition of new claims 21-32 filed 10 December 2007.

#### ***Claim Objections***

2. Claims 21, 23, 24, 26, and 29-32 are objected to because of the following informalities:

- a. In regards to claim 21, line 12, the phrase "the axis" should be changed to "an axis" since this limitation is not recited in the preceding lines of the claim.
- b. In regards to claims 21, 23, 24, 26, and 29-32, in all instances referring to the second data storage module, the language to be used should be "the at least one data storage module" in order to be consistent with the language used in the independent claims.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 21-32 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. **In regards to the claims**, it is unclear whether applicant is intending to claim the method of assembly of the key or the structure. For examination purposes, the claims will be considered structural recitations until further clarification from applicant.

6. **In regards to the claims**, it is unclear whether applicant intends to claim "at least one first data storage module" or just "a first data storage module." Furthermore, the drawings only show one first data storage module. For examination purposes, the claims will be given a broad interpretation until further clarification from applicant.

7. **In regards to claim 21, line 9, and claim 27, line 7**, the phrase "formed in a unit" is unclear. Furthermore, in line 25 of claim 21 and in line 18 of claim 27, the language recites that the key is "latched" to the cap. This limitation of latching requires some type of locking components, but the claim fails to disclose any structural components that would "latch" the key and cap together. For examination purposes, the claim will be given a broad interpretation until further clarification from applicant.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 21-23, 25-28, and 31 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Lerchner et al. (US-5878611) in view of Leuling et al. (WO02075669) in further view of Bishop et al. (US-5181605).

11. **In regards to claims 21, 27, and 31**, Lerchner et al. discloses an electronic locking device having at least one lock unit 29 and a security key 2, wherein the security key includes a control circuit and transmitting and receiving circuit which transmits information signals to the control circuit 30 of the other respective unit that is contained in one unit with the storage module 20 (Col. 3, lines 17-21 and lines 33-40). Lerchner further discloses that the security key has a mechanical part (portion between reference characters 7 and 6, Figure 1) with a shank 5 engaged together by an extended shank region (portion between reference characters 32 and 11, Figure 1). The shank has control areas (portion engaged with lock unit, Figure 3) and the extended shank region has a recess 25 along an axis (axis extending from reference character 7 to reference character 5, Figure 1) of the security key in which at least one first data storage module 20 connected to a first antenna 22 is engaged (Figure 2). The first data storage module is inserted into a recess 25 in the mechanical part. Lerchner et al. discloses the first data storage module, but lacks at least a second data storage module that can be or is fitted in another recess 25' symmetric to the recess having the first data storage module with its own antenna and operates at a different frequency than that of the first module. Leuling et al. teaches a security key 1 having two data storage modules 7, 8 capable of

operating at two different frequencies (paragraph 11 of the translation). Since the security key disclosed by Lerchner et al. has a second recess for capable of holding a second data storage module and Leuling et al. teaches the use of two data storage modules with two different frequencies in a security key, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add another data storage module to the key disclosed by Lerchner et al. since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

12. Lerchner et al. in view of Leuling et al. discloses a cap 3, 13 into which at least the second data storage module is adapted to be inserted on the mechanical part (Figure 3), and is engaged over the extended shank region. Lerchner in view of Leuling et al. fails to disclose that the cap has a first slot and a second slot communicating with a chamber that is capable of accommodating the at least one second data storage module and the second antenna. Bishop et al. teaches a cap 18 having an upper edge with a first slot 34 and a lower edge with a second slot 38, and the first slot and second slot communicating with a chamber 36 within the cap. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cap with slots to cover and protect the components of the key taught by Lerchner et al. in view of Leuling et al. in order to enhance the security and durability of the key. Furthermore, it apparent that the at least second data storage module would be located in the chamber since the key would be located in the chamber for protection.

13. **In regards to claims 22 and 28**, Bishop et al. teaches that the cap is formed as a unit and is produced from plastic (Col. 2, line 56).

14. **In regards to claim 23**, Lerchner in view of Leuling et al. in further view of Bishop et al. teaches that the at least one second data storage module is located in the cap below a head (top portion of mechanical part with hole, Figure 3) and adjacent to the extended shank region (apparent from Figure 3 and Leuling et al.).

15. **In regards to claim 25**, Lerchner et al in view of Leuling et al. discloses that on at least one narrow side (side with first data storage module and antenna, Figure 3) the mechanical part has a milled section 3 for accommodating the antenna 22 of the first data storage module (Figure 3).

16. **In regards to claim 26**, Lerchner et al in view of Leuling et al. discloses that the security key can include first and second data storage modules operating at different frequencies. Leuling et al. further teaches that the different frequencies of the two data storage modules allow them to affect different components within an electronic locking device (paragraphs 23 and 24 of the translation), therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify that the second data storage module be capable of affecting a different component of the electronic locking device than the lock unit affected by the first data storage module since it is well-known to use different frequencies for different situations, i.e. send a signal to actuate an access control unit instead of a lock, as taught by Leuling et al.

17. **Claims 24, 29, 30, and 32 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Lerchner et al. (US-5878611) in view of Leuling et al. (WO02075669) in further view of Bishop et al. (US-5181605) as applied to claims 21-23, 25-28, and 31 above, and further in view of Tanaka et al. (US-4922736).

18. **In regards to claims 24, 29, 30, and 32**, Lerchner et al. in view of Leuling et al. in further view of Bishop et al. fails to specify that the cap contains openings and portions for capable for accommodating the at least one second data storage module. Tanaka et al. teaches a cap 3 having openings and portions for accommodating the electrical components of the key (Figure 2). Since the modification of the chamber of the cap taught by Bishop et al. to accommodate the at least one second data storage module would not hinder the ability of the key to cooperate with a lock unit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shape of the chamber taught by Bishop et al. to accommodate and fit to the shape of the key and its electrical components.

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 21-32 have been considered but are moot in view of the new ground(s) of rejection.
20. The examiner acknowledges applicant's amendments to the specification and the drawings.
21. The rejection of claims 1 and 16 under 112, second paragraph, are withdrawn since these claims have been cancelled.

### ***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALYSON M. MERLINO whose telephone number is (571)272-2219. The examiner can normally be reached on Monday through Friday, 7:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3676

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer H Gay/  
Supervisory Patent Examiner, Art  
Unit 3676

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Examiner, Art Unit 3673  
March 1, 2008